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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,628	01/22/2004	Jan Constant Cool	30394-1116	5051

5179 7590 08/31/2006

PEACOCK MYERS, P.C.  
201 THIRD STREET, N.W.  
SUITE 1340  
ALBUQUERQUE, NM 87102

EXAMINER
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SWEET, THOMAS

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/762,628

Applicant(s)

COOL ET AL.

Examiner

Thomas J. Sweet

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 07/17/2006 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., allow the user to assume a natural gait) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The structure and structural relationship is not claimed in enough detail that one would recognize that the prosthetic allows the user to assume a natural gait. The claims discuss rotation of the lower leg with respect to the toe about an imaginary center, which does not equate with or is not recognizable as a natural gait.

Applicant's arguments with respect to claims 8-13 have been considered but are moot in view of the new ground(s) of rejection.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "lower leg portion is able to rotate with respect to the toe portion around a center of rotation which is located at an imaginary intersection of the front portion of the foot and the said first coupling element" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing

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sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claim 9 is objected to because of the following informalities: "components" appears to be misspelled as "compounds". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in

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the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The “lower leg portion is able to rotate with respect to the toe portion around a center of rotation which is located at an imaginary intersection of the front portion of the foot and the said first coupling element” is not enabled. The only point on the lower leg portion, which rotates around a center of rotation with respect to the toe, is 3 and the center of rotation is 2. The lower leg portion has a compound movement through space. Point 3 rotates around point 2 because it is linked by front foot portion 1. The first coupling element does not have a fixed length (since it is a spring), so no other part of the lower leg portion can be said to rotate around a fixed center as a result of movement with respect to the toe portion.

Claims 8-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. One of ordinary skill in the art would not recognize possession of coupled limb forming components configured such that “lower leg portion is able to rotate with respect to the toe portion around a center of rotation which is located at an imaginary intersection of the front portion of the foot and the said first coupling element”. As discussed above the components can’t move as claimed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 8-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Assuming for illustration that the 4-bar linkage claimed has fixed length bars, the imaginary intersection the two rotating bars (front foot and first coupling) moves as the bars move with respect to one another, so it can't be said that that intersection is a center of rotation, since it doesn't anchor rotation. The addition of the first coupling not being of fixed length (i.e. a spring as in claim 11) and not having a predictable length as claimed (no structural relationship), further renders the claim indefinite. Assuming such a center of rotation is possible with the 4-bar linkage in the claims, the claims are incomplete for omitting essential structural cooperative relationships of elements and/or essential element(s), which are unknown.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-13 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Elsasser. Elsasser discloses a prosthesis or

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orthosis for the foot, comprising limb forming components (fig. 1), which components comprise at least a lower leg portion (1, 11 and 13), a front portion of the foot (3, 8, and 9), and a toe portion (4) which components are connected by pivoting couplings (the pin between 11 and 8, the pin between 9 and 13 and the pin 23), and at least a first coupling element (24) whose ends are coupled with said lower leg portion (at 25) and said toe portion (at 26), and is fully capable of having the lower leg portion be able to rotate with respect to the toe portion around a center of rotation which is located at an imaginary intersection (there are an infinite number of hypothetical intersection between various axis of the two components) of the front portion of the foot and the said first coupling element (the leg portion can be pivoted around any point with respect to the toe, e.g. by laying the prosthesis on a turn table such that the toe is closer to the center of the turn table, and also as shown in fig 3 as discussed below with regard to claim 10).

With regard to claim 10, said center of rotation is located under the toe portion (at the point of contact between 4 and the floor as shown in fig. 3) when the toe portion rests on a surface during walking.

With regard to claim 11, said first coupling element is a spring (24).

With regard to claim 12, there is a heel portion (2), which heel portion is connected to said lower leg portion by a pivoting coupling (at 5).

With regard to claim 13, at least a second coupling element (9) is present whose ends are coupled (at 6 and the pin between 13 and 9) with said heel portion (2) and said lower leg portion (1, 11 and 13).

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Claims 8-13 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Collier et al. Collier et al discloses a prosthesis or orthosis for the foot, comprising limb forming components (fig. 1), which components comprise at least a lower leg portion (12), a front portion of the foot (28), and a toe portion (14) which components are connected by pivoting couplings (20 and 38), and at least a first coupling element (42) whose ends are coupled (in contact under compression at 29 and 30) with said lower leg portion (at 29) and said toe portion (at 30), such that the lower leg portion (12) is able to rotate (14 is a spring which flexes allowing 12 to rotate) with respect to the toe portion around a center of rotation (i.e. the ground contact of 14 at 32) which is located at an imaginary intersection (an infinite number of axis extend through each of the components and including and intersection point at the ground contact at 32) of the front portion of the foot and the said first coupling element (and fully capable as discussed above with respect to Elsasser).

With respect to claim 11, said first coupling element is a spring (42).

With respect to claim 12, there is a heel portion (28a), which heel portion is connected to said lower leg portion by a pivoting coupling (20).

With respect to claim 13, at least a second coupling element (27) is present whose ends are coupled with said heel portion (28a) and said lower leg portion (12).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Sweet whose telephone number is 571-272-4761. The examiner can normally be reached on 6:30 am - 5:00pm, M-Th.

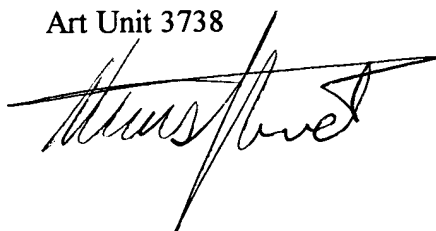


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M. McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas J Sweet  
Examiner  
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A handwritten signature in black ink, appearing to read 'Thomas Sweet', with a long horizontal stroke extending to the left.